

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Bulucea, Constantin; Rossen, Rebecca
Assignee: Siliconix Incorporated
Title: TRENCH DMOS POWER TRANSISTOR WITH FIELD SHAPING BODY PROFILE AND THREE-DIMENSIONAL GEOMETRY
Serial No.: 08/851,608 Filed: 05/05/97
Examiner: J. Carroll Group Art Unit: 2811
Docket No.: M-799-4C US

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approved

J. Mac

FEB 03 1999

ASSISTANT COMMISSIONER FOR PATENTS
TECHNOLOGY CENTER 2800
Washington, D. C. 20231 SPECIAL PROGRAM CENTER

**TERMINAL DISCLAIMER TO OBLIGATE A
DOUBLE PATENTING REJECTION OVER A PATENT**

Sir:

Petitioner, Siliconix Incorporated, a Delaware corporation having a place of business at 2201 Laurelwood Road M/S 38, Santa Clara, CA 95054 -0951 is the owner of the entire interest in the instant application. Petitioner hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,072,266. Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later expires for failure to pay a maintenance fee, is held

LAW OFFICES OF
SKJERVEN, MORRILL,
MacPHERSON, FRANKLIN
& FRIEL LLP

25 METRO DRIVE
SUITE 700
SAN JOSE, CA 95110
(408) 453-9200

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unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

The undersigned (whose title is supplied below) represents that he/she is a representative authorized to sign on behalf of Petitioner.

I declare that all statements made herein of my own knowledge are true, all statements made herein on information and belief are believed to be true, and all statements made herein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties including fine or imprisonment or both as set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or this document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom.

6/17/99
DATE

Edward C. Kwok
SIGNATURE

Reg. no. 33,938
Edward C. Kwok
Attorney for Applicants

T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 03-Feb-00APPL. S.N.: 08/851,608TO: EXAMINER Carroll, JamesART UNIT: 2811FROM: Macaluso, Jo

PARALEGAL SPECIALIS

RETURN THIS MEMO TO: CP4-6D28SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: *21 SUN 99*03-Feb-00

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete, please initial, date and return this memo to me. THANK YOU.

- The T.D. is PROPER and has been recorded (see ¶ 14.23).
- The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶ 14.24):
- The TD fee of has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶ 14.26.07).
 - The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶¶ 14.26 & 14.26.01).
 - The T.D. lacks the enforceable only during common ownership clause – needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see ¶ 14.27.01).
 - The T.D. is directed to a particular claim(s), which is not acceptable since “the disclaimer must be for a terminal portion of the term of the entire patent to be granted” (MPEP 1490) (see ¶¶ 14.26 & 14.26.02).
 - The person who signed the T.D.:
 - is not an attorney “of record” (see ¶¶ 14.29 and 14.29.01).
 - has failed to state his/her capacity to sign for the business entity (see ¶ 14.28).
 - is not recognized as an officer of the assignee (see ¶¶ 14.29 & possible 14.29.02).
 - No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶ 14.30).
 - The T.D. is not signed (see ¶¶ 14.26 & 14.26.03).
 - The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶ 14.32).
 - The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed) is missing or incorrect (see ¶¶ 14.26, 14.27.02 or 14.26.05).
 - The period disclaimed is incorrect or not specified (see ¶¶ 14.26, 14.27.02 or 14.26.03).
 - Other: TECH SUPPORT: CARGE TD FEE OF \$110.00 TO DEPOSIT ACCOUNT 19-2386
 - Suggestion to request refund (see ¶ 14.36). NOTE: If already authorized, credit refund to deposit account and **do not** check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials: _____ Date: _____

Log Date: